

REMARKS

In the Office Action¹, the Examiner:

rejected claims 1, 9, 17, and 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement;

rejected claims 1-5, 9-13, and 17-21 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Publication 2002/0059127 to Brown et al. ("Brown") in view of U.S. Patent No. 7,016,870 to Jones et al. ("Jones");

rejected claims 7, 8, 15, 16, and 23-25 under 35 U.S.C. § 103(a) as allegedly obvious over Brown and Jones in view of U.S. Patent Publication 2005/0262014 to Fickes ("Fickes")

rejected claim 27 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, and Fickes in view of U.S. Patent Publication 2004/0158479 to Adhikari ("Adhikari"); and

rejected claim 28 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, Fickes and Adhikari, in view of Official Notice.

Claims 1-5, 7-13, 15-21, 23-25, 27, and 28 are pending in this application.

Applicant proposes to amend claims 1, 9, 17, and 25. No new matter is added by this Amendment. Applicant respectfully requests that these amendments be entered since these amendments were solicited by the Examiner in the Office Action on, for example, page 3. Furthermore, Applicant asserts that these amendments put the application in condition for allowance or alternatively in better form for appeal and should be entered.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Applicant respectfully traverses the rejection of claims 1, 9, 17, and 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1, 9, 17, and 25 are proposed to be amended in a manner to overcome the 35 U.S.C. § 112, first paragraph rejection.

The Office Action states “it is not clear to the examiner in the claim language how [the book value] is determined (N.B. ‘querying’ a value or ‘ascertaining’ [a value] from a system is not ‘determining’ it.” Office Action p. 2-3. Without conceding that querying a value or ascertaining a value from a system is not determining it, Applicant proposes to amend claims 1, 9, 17, and 25 in a manner that should clarify that the “book value for each object in an accounting system” is “automatically ascertain[ed] by a processor.” The claims need not recite the exact process of how the “book value” is “ascertain[ed].” Applicant submits the claimed “ascertaining” is enabled since the features are described in the disclosure such that one of ordinary skill in the art would recognize, from the disclosure, what “ascertaining” entails. Applicant submits that the term “ascertaining” is enabled by the disclosure for one of relevant skill in the art. Specification p. 4 lines 22-23. Accordingly, the rejection of claims 1, 9, 17, and 25 under 35 U.S.C. § 112, first paragraph, should be withdrawn since the claims are fully enabled.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims because the claims have been improperly construed and because Brown does not teach or suggest each and every feature of claim 1 as asserted by the Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2154. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

The Office Action states “[f]or purposes of examination, the limitation ‘automatically determining, by a processor, a book value for each object in an accounting system’ will be interpreted to read: ‘automatically **reading**, by a processor, a book value for each object in **from an** accounting system” (emphasis original). Office Action p. 3. But, then the Office Action states “For purposes of examination, the claim language [determining a book value] will be interpreted to read ‘inputting a book value.’” Office Action p. 4. Thus, the Office Action has construed the same claim recitation in two different ways. Specifically, the Office Action states that it interprets “automatically determining” as both “automatically reading” and “automatically inputting.” But, “reading” and “inputting” are inconsistent claim interpretations.

Because the Office Action has interpreted the claims in an inconsistent manner, a *prima facie* case of obviousness has not been established at least because the Office Action has not properly ascertained the “differences between the claimed invention and the prior art” per M.P.E.P. § 2141 (II)(B). As such, the basis for the rejection under 35 U.S.C. § 103(a) is incorrect. Applicant submits that even if the proposed amendment does not render the claims allowable, Applicant should be provided a consistent interpretation of the claims in order to properly respond to the rejections. Accordingly, Applicant requests that if the finality of the Office Action be withdrawn.

Notwithstanding the above discussion, a *prima facie* case of obviousness has not been established with respect to claim 1 because, regardless of the interpretation of the above discussed claim elements, Brown does not disclose or suggest each and every feature of claim 1 as alleged in the Office Action.

For example, claim 1 recites, in part, "automatically performing one or more actions depending upon the manner or degree to which one or more of the presettable conditions are satisfied." Brown does not disclose or suggest at least this feature of claim 1.

The Office Action does not identify any reference as describing or suggesting this feature of claim 1. For example, the Office Action states "Brown does not explicitly disclose presenting advice for a degree to which the conditions are satisfied on a display before a sale or purchase of each object." Office Action p. 7. But, this assertion of what Brown allegedly fails to teach is not equivalent to the recitations of claim 1. In other words, by alleging that Brown does not disclose the claimed "advice," the Office Action has not shown that Brown discloses the claimed "automatically performing one or more actions depending upon the manner or degree to which one or more of the presettable conditions are satisfied." *Id.* The Office Action apparently glosses over this element of claim 1 to instead show that the claimed "one or more actions comprising . . . presenting advice for a degree to which the conditions are satisfied on a display" is disclosed in Jones. The Office Action seems to assume that if there is disclosure of "presenting advice for a degree to which the conditions are satisfied on a display" there is also disclosure of the claimed "automatically performing one or more actions depending upon the manner or degree to which one or more of the presettable conditions are satisfied."

As the Office Action correctly notes, Brown does not disclose this "automatically performing one or more actions depending upon the manner or degree to which one or

more of the presettable conditions are satisfied” element of claim 1. Brown discloses that when a “predetermined tax loss threshold” is met, “the security is automatically sold to provide tax losses for offsetting gains in the portfolio.” Brown paragraph [0014]. Brown makes no accommodation for the “manner or degree to which one or more of the presettable conditions are satisfied.”

Jones, however, does not remedy the deficiency of Brown. The Office Action alleges that Jones discloses “a financial advisory system which produces forecasts for financial advisory services [column 3 lines 40-57]. He further discloses recommending portfolio allocations [column 17 lines 44-62] and recommending a fixed target asset-mix [column 19 lines 10-18] as well as other investment mix/balancing strategies throughout. He further discloses displaying allocation for optimal portfolios [column 7 line 56-column 8 line 2] and alerts to notify users of advice [column 28 lines 24-37].” Office Action p. 7-8. The Office Action concludes “it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Brown’s invention to include recommending portfolio allocations as taught by Jones.” Office Action p. 8.

Thus, it seems that the Office Action is alleging that “recommending portfolio allocations” constitutes the claimed “one or more actions.” But, there is no disclosure in Jones that the “recommending portfolio allocations” is performed “depending on the manner or degree to which one or more of the presettable conditions are satisfied.” Indeed, the Office Action does not even allege that “recommending portfolio values” in Jones “depend[s] on the manner or degree to which one or more of the presettable conditions are satisfied.”

For at least this reason, the Office Action has not satisfied its burden to state a *prima facie* case of obviousness with respect to claim 1. Accordingly, claim 1 is allowable because Brown and Jones, whether taken singly or in combination, do not disclose or suggest each and every element of claim 1. Applicant respectfully requests that the rejection be withdrawn.

Notwithstanding the above, claim 1 is allowable because Brown teaches away from Jones. For example, Brown states “[f]or each tax lot, the difference between the present market value of the security and a past historical value of the security is calculated and compared to a predetermined tax loss threshold, the security is automatically sold to provide tax losses for offsetting gains in the portfolio” (emphasis added). Brown paragraph [0014].

Brown makes no provision for the “manner or degree to which one or more of the presettable conditions are satisfied” as claimed in claim 1. In Brown, regardless of whether the alleged “condition” is met, slightly exceeded, or exceeded by a great deal, Brown discloses “the security is automatically sold.” Brown paragraph [0014]. Thus, there can be no rational reason, motivation, or suggestion to combine Brown with Jones because the “recommend[ation of] portfolio allocations” taught by Jones is meaningless in the context of Brown. If Brown is interested in harvesting tax losses, there is no reason that one of ordinary skill in the art would “recommend portfolio allocations” that make money. Making money is contrary to the purpose of Brown because Brown is harvesting losses to “offset gains in the portfolio.” Brown paragraph [0014]. Thus, there is no reason then why Brown would include the “recommend[at]ions of] portfolio

allocations” taught by Jones. Accordingly, since there is no motivation to combine Brown and Jones, a *prima facie* case of obviousness has not been established with respect to claim 1. The rejection should be withdrawn.

Finally, and notwithstanding the above, Brown teaches away from Jones for another distinct reason. Claim 1 recites that “the one or more actions are performed before a sale or purchase of each object.” If, as discussed above, Brown is interested in the “automatic sale” of a security as soon as the “predetermined tax loss threshold” is met (Brown paragraph [0014]), there is no reason to modify Brown to include “investment mix/balancing strategies” taught by Jones, as the Office Action alleges. Office Action p. 8. In other words, there is no reason that one of ordinary skill in the art would have modified Brown, which is interested in losing money for tax purposes, with Jones to provide “recommend[ed] portfolio allocations” to make money prior to the “sale or purchase of each object” as claimed in claim 1. If Brown’s tax losses were reallocated before the disclosed “automatic sale” in order to make money as taught in Jones, it would frustrate the purpose of Brown because Brown is trying to maximize the amount of money lost to offset tax liability for capital gains purposes. Accordingly, Brown teaches away from Jones because Jones, if combined with Brown, frustrates the purposes of Brown. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1. As such, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 9, 17, and 25 contain features similar to those discussed in connection with claim 1. None of Fickes, Adhikari, or Official Notice remedy any of the

deficiencies of Brown and Jones as outlined above. Applicant therefore asserts that these claims are allowable for at least similar reasons as claim 1. In instances where the Examiner has relied on Official Notice, Applicant requests the Examiner provide evidence of each and every assertion made in the Office Action.

The dependent claims are allowable for at least the same reasons as the independent claims from which these dependent claims depend. Applicant respectfully requests the Examiner withdraw the rejections of the claims under 35 U.S.C. § 103 and allow the claims.

CONCLUSION

Applicant respectfully requests that the Examiner consider this response under 37 C.F.R. § 1.116, establishing that the pending claims are in condition for allowance.


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 
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